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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,897	05/24/2001	Thomas Zwick	82262	6604

7590 12/05/2003

Welsh & Katz  
22nd Floor  
120 South Riverside Plaza  
Chicago, IL 60606-3913

EXAMINER
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JAMAL, ALEXANDER

ART UNIT	PAPER NUMBER
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2643

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DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/786,897

Applicant(s)

ZWICK, THOMAS

Examiner

Alexander Jamal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5-24-2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claim 1** rejected under 35 U.S.C. 102(e) as being anticipated by Scott et al. (5870046).
  - a. **Claim 1:** Scott discloses a device for the DC decoupled connection of a telephone line to a signal processing device (modem) with a first circuit (telephone circuitry 118 in Fig. 1) connected via the telephone line to the public phone system (Fig. 1) comprising:

- i. A first circuit 118 (Fig. 1) connected to the telephone line.
  - ii. A second circuit 116 (Fig. 1) connected to the signal processing device.
  - iii. Circuit 1 that comprises hybrid circuitry (decoder 708, encoder 712, A/D 711 and D/A 709 converters in Fig. 7) to separate the signals of the telephone line (bi-directionally) (reference 736, 740 in Fig. 7) in a first signal path from the telephone line to the signal processing device, and in a second processing path extending from the signal processing device to the telephone line (Col 16 lines 1-16 and lines 35-50).
  - iv. Isolation barrier 120 (Fig. 1) that may be a transformer configured to provide isolation between primary and secondary windings (Col 1 line 56 to Col 2 line 4).
  - v. Scott specifies that the transformer is configured to provide isolation between the primary and secondary windings (Col 1 line 56 to Col 2 line 4). As such the transformer would be configured with the primary winding coupled to the first circuit and the secondary winding coupled to the second circuit with the first and second windings being DC decoupled from one another.
  - vi. Scott's circuit is designed to bi-directionally transmit signals in both signaling paths in a TDM method that is coupled by the transformer in both directions (Col 16 lines 36-50, Col 17 lines 4-12).
- b. **Claim 2:** In Scott's device, the first circuit comprises (in Fig. 7) an A/D converter 711 that follows the hybrid circuit via encoder 712 in the first signal path, and

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D/A converter 709 that follows the second signal path and precedes the hybrid circuit via decoder 708.

**c. Claim 3:** The output of A/D converter 711 (Fig. 7) and the input of D/A converter 709 are connected to a first signal digital multiplexer (Encoder 712 and Decoder 708) that is coupled to the first side of isolation barrier 705 via driver 713. The isolation barrier may be the first winding of an isolation transformer (Col 1 line 56 to Col 2 line 4).

**d. Claim 4:** The first multiplexer is operated such that the first and second signaling paths are alternatively connected to the isolation barrier (which may be a transformer) (Col 16 lines 16-35).

**e. Claim 5:** The second circuit comprises a multiplexer (Encoder 702, Decoder 714 in Fig. 7) that is connected to the secondary side of the isolation barrier that may be a secondary winding of a transformer (Col 1 line 56 to Col 2 line 4).

**f. Claim 6:** The second circuit comprises oscillator circuit 704 (Fig. 7) that provides the clock for the second multiplexer circuit.


**g. Claim 7:** The first multiplexer (Fig. 7) comprises clock recovery circuit 707 that recovers the clock signal from oscillator 704 and provides it to the first circuit (Col 15 line 59 to Col 16 line 16).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ  
November 25, 2003

  
DUC NGUYEN  
PRIMARY EXAMINER